

Amendment and Response

Serial No.: 09/479,648

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For: METHOD OF APPLYING ADHESIVE COATED FILM

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serves as its own disclosure.

Further, it is clear from the specification that the apparatus and methods of the present invention may be used with a variety of films, including films having removable adhesive coated thereon. For example, the present invention makes it possible to adhere films to trailers and other challenging environment areas with comparatively low stress and/or film memory, such that adhesives that are much less aggressive may now be used in these challenging environments. *See* Specification, page 9, lines 29-32. Thus, removable or repositionable adhesives may now much more readily be used. *Id.* at page 9, line 23 through page 10, line 1. In other words, one skilled in the art would understand that the kit of claim 31 may include a film having removable adhesive coated thereon.

As for antecedent basis of the terms used in claim 31, Applicants reiterate that all of the terms used in claim 31 are present in the specification as filed. For example, the term "removable adhesive" is discussed in the paragraphs beginning on page 9, line 24; page 16, line 1; page 16, line 6, etc. Reconsideration and withdrawal of this objection are, therefore, respectfully requested.

Claim Objections

Claims 43-44 were objected to as being of improper dependent form. Applicants have cancelled claims 43-44, thus rendering this objection moot.

The 35 U.S.C. § 112, First Paragraph, Rejection

Claims 41-42, 45-46, and 62-63 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action alleges that the specification indicates that the envisioned method is intended for use on a truck trailer side and not on an unspecified wall. Applicants traverse this rejection.

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Claims 41-42, 45-46, and 62-63 meet the requirements of 35 U.S.C. § 112, first paragraph, because one skilled in the relevant art would understand that the inventors had possession of the claimed invention at the time that the application was filed.

For example, claim 41 recites that the substrate includes a wall. The present invention provides "excellent adhesion of thermoplastic films to highly irregular or textured surfaces, such as concrete, cement block, stucco, brick, fabric surfaces, carpeted surfaces and the like." Specification, page 3, lines 29-31. Contrary to the allegations of the Office Action, the specification does not limit use of the present invention to sides of truck trailers because few, if any, truck trailers have sides that include concrete, cement block, stucco, brick or carpeted surfaces. On the other hand, one skilled in the art would understand that walls may include concrete, cement block, stucco, brick, fabric surfaces, carpeted surfaces, etc.

However, the Office Action further alleges that Applicants did not intend to use the present invention on walls because the specification at page 4, lines 17-19 states that the vehicle environment disclosed constitutes a "vastly different" environment and prior art area than the generalized wall application now claimed. Applicants traverse this allegation and submit that it is a mischaracterization of this passage of the specification.

In the specification beginning at page 4, line 11, Applicants draw an analogy between the present invention and the application of wallpaper to a wall. Applicants state that applying adhesive-coated film to challenging surfaces such as truck trailers is much more difficult than applying wallpaper to a wall because the wall "is usually even and does not contain compound geometrical or irregular surfaces." In contrast to applying wallpaper to such a wall, applying an adhesive-coated film to a substrate such as the side of a truck trailer "occurs in a vastly different environment" than applying wallpaper to a typical wall having no topographical irregularities. One skilled in the art would understand that this analogy does not limit the present invention to use with a truck trailer.

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For at least the above reasons, Applicants submit that claims 41-42, 45-46, and 62-63 are patentable under 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 20 and 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gladen (U.S. Patent No. 3,562,059).

Applicants traverse this rejection and submit that claims 20 and 22-23 are not *prima facie* obvious in view of Gladen for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 20 and 22-23 are not *prima facie* obvious because no motivation or suggestion is identified in the Office Action that would lead one of skill in the art to modify the teachings of Gladen to produce the present invention. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. See M.P.E.P. § 2142. This burden has not been satisfied with respect to the rejection of claims 20 and 22-23.

Claim 20 recites that the heat source and the pressure source do not simultaneously apply heat and pressure to the same location of the film. In contrast to claim 20, Gladen teaches a press that includes a piston 8 and a heating platen 9 mounted on the piston 8. The press simultaneously applies heat and pressure to a formed polymer body. See, e.g., Gladen, column 2, lines 21-24. No motivation or suggestion is provided in the Office Action as to why one of skill in the art would modify Gladen such that the press taught by Gladen does not simultaneously

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apply heat and pressure to the same location of the formed polymer body. Absent any identified motivation or suggestion to modify Gladen, claims 20 and 22-23 cannot be *prima facie* obvious.

Further, modifying Gladen as proposed by the Office Action would change the principle of operation of the invention taught by Gladen. If the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference is not sufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01. Modifying the press taught by Gladen as asserted in the Office Action such that heat and pressure are not simultaneously applied to the same location on the polymer body would change the principle of operation of the press. As a result, Applicants respectfully submit that the asserted motivation cannot form the basis for a proper *prima facie* obviousness rejection.

There is also no assertion that Gladen teaches all of the elements of claim 20. For example, claim 20 recites that the pressure source includes a Heat Neutral Pressure Source. As defined in the specification, a Heat Neutral Pressure Source is a pressure source that "has thermal conductivity characteristics and surface characteristics at the point of contact with the film such that the film, when nearly melted, will not adhere to the Heat Neutral Pressure Source during application in accordance with the method of the present invention to a surface." Specification, page 5, lines 17-21. The film-contacting portion of the Heat Neutral Pressure Source has a geometry such that "a soft or melted film does not distort or adhere to the device in a manner that would result in tearing or other such damage to the film." *Id.* at page 5, lines 29-32. In contrast to claim 20, Gladen teaches placing a teflon cloth on the film and foam prior to simultaneously applying heat and pressure. See Gladen, column 1, lines 63-66. After bonding, the teflon cloth is removed, leaving a "fine screen texture" in the foam and film. *Id.* at column 2, lines 4-11. In other words, the teflon cloth distorts the surface of the foam; therefore, the teflon cloth is not a Heat Neutral Pressure Source as alleged by the Office Action.

Claims 22-23, which depend from claim 20, are not *prima facie* obvious in view of Gladen for the same reasons as presented above for claim 20. In addition, claims 22-23 each recite additional elements that further support patentability when combined with claim 20.

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For at least the above reasons, Applicants submit that claims 20 and 22-23 are not *prima facie* obvious in view of Gladen. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 20-28, 57-61, and 65-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hargarter et al. (U.S. Patent No. 5,674,600) in view of Gladen.

Applicants traverse this rejection and submit that claims 20-28, 57-61, and 65-66 are not *prima facie* obvious because there is no motivation or suggestion to combine the teachings of Hargarter et al. and Gladen to produce the present invention. In fact, Gladen teaches away from being combined with Hargarter et al. It is improper to combine references where the references teach away from their combination. See M.P.E.P. § 2145.

For example, Gladen teaches a method of decorating plastics such that the plastics do not require pretreatment, e.g., flame treatment. See Gladen, column 1, lines 26-31. Hargarter et al., on the other hand, teaches a method of bonding a laminating film to porous substrates. See Hargarter et al., column 6, lines 55-57. In each example given, Hargarter et al. pretreats the porous substrates prior to bonding the laminating films onto the substrates. For example, Hargarter et al. teaches laminating the films to "the corona pretreated side of a conventional commercial single layer TPU film" *Id.* at column 11, lines 44-49. Further, Hargarter et al. teaches attaching the disclosed films to substrates that "were flame-laminated textile/cut foam/Walopur 2102 AK, 35 μm @ [sic] structures. The tapes were stuck to the corona pretreated side of the Walopur 2102 AK." In other words, Hargarter et al. teaches that the substrates are pretreated prior to being bonded with the disclosed laminating films. This is in direct contrast to the teachings of Gladen. Therefore, one skilled in the art would not be motivated to combine the teachings of Hargarter et al. and Gladen to produce the present invention.

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For at least the above reasons, Applicants submit that claims 20-28, 57-61, and 65-66 are not *prima facie* obvious in view of the cited references. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Allowable Subject Matter

Applicants acknowledge that claims 29-31, 34-40, and 64 recite allowable subject matter.

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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

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By

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09 JULY 2002

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 9th day of July, 2002, at 2:25 pm (Central Time).

By: Richard Engelhardt-GebhardtName: Richard Engelhardt-Gebhardt